

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Atty Dkt. 330-231

C# M#

TAMURA

TC/A.U.

1774

Serial No. 09/766,318

Examiner: Ferguson

Filed: January 19, 2004

Date: September 28, 2004

Title: HEAT-RESISTANT GLASS FIBER AND PROCESS FOR THE PRODUCTION THEREOF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE/AMENDMENT/LETTER

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

☒ **Correspondence Address Indication Form Attached.****Fees are attached as calculated below:**

Total effective claims after amendment 0 minus highest number
previously paid for 20 (at least 20) = 0 x \$ 18.00 \$ 0.00

Independent claims after amendment 0 minus highest number
previously paid for 3 (at least 3) = 0 x \$ 86.00 \$ 0.00

If proper multiple dependent claims now added for first time, add \$290.00 (ignore improper) \$ 0.00

Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s) (\$110.00/1 month; \$420.00/2 months; \$950.00/3 months) \$ 0.00

Terminal disclaimer enclosed, add \$ 110.00 \$ 0.00

☐ First/second submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$770.00) \$ 0.00

☐ Please enter the previously unentered , filed

☐ Submission attached

Subtotal \$ 0.00

If "small entity," then enter half (1/2) of subtotal and subtract -\$ 0.00

☐ Applicant claims "small entity" status. ☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee (\$180.00) \$ 0.00

Assignment Recording Fee (\$40.00) \$ 0.00

Other: 0.00

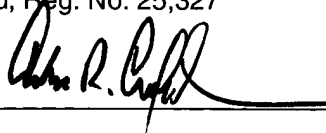
TOTAL FEE ENCLOSED \$ 0.00

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

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NIXON & VANDERHYE P.C.
By Atty: Arthur R. Crawford, Reg. No. 25,327

Signature: _____





IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

TAMURA

Atty. Ref.: 330-231; Confirmation No. 6090

Appl. No. 09/766,318

TC/A.U. 1774

Filed: January 19, 2001

Examiner: Ferguson

For: HEAT-RESISTANT GLASS FIBER AND PROCESS FOR THE PRODUCTION
THEREOF

* * * * *

September 28, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE

This is responsive to the Official Action of July 13, 2004. Claims 1-6 are pending in this application.

Responsive to the question posed in item 2 of the Official Action, the amendments to claims 1 and 6 are correct as presented. The relevant temperature range may be found on page 9 of the specification under heading (6) Heat Resistance. This was also explained on page 4, third full paragraph of the Amendment and Response filed February 9, 2004 identifying the basis when this feature was added to claims 1 and 6.

As explained in the previous response, claims 1 and 6 were amended to employ "consisting essentially of" terminology to make it clear that applicant's compositions do not include titanium dioxide. The examiner recognizes the significance of this amendment on page 4, item 4, second sentence of the Official Action. To this TiO₂ exclusion it is argued that titanium dioxide is a known colorant that does not materially affect the basic and novel characteristics of the claimed invention, reference being made to MPEP §2111.03. This

comment is understood to mean that the presence of titanium dioxide in the Sproull reference "does not materially affect the basic and novel characteristics of the invention disclosed in that patent." This assertion is totally orthogonal to the disclosure of the Sproull reference.

The document itself makes it clear that 1 to 5% TiO₂ is necessary and a central component of this reference. For instance there are passages such as "Applicant has now discovered that TiO₂ containing glass fibers ... can be made such that they possess properties rendering them suitable for reinforcements in electrical applications" (*see* column 2, lines 42-47). The "most preferred" embodiment is one that contains 1.5% TiO₂ (*see* column 3, lines 15-17). All of the working examples include 1.5% TiO₂ and indeed the patentee observes "It is now possible to use TiO₂ in glass fibers at the claimed level (1-5%) to provide a fiber useful as a support or reinforcement for electrical application" (*see* column 6, lines 46-49). All of the claims issued in the Sproull patent include the presence of either 1.5% TiO₂ or an amount ranging from 1 to 1.8% TiO₂.

Counsel observes that when summarizing the said-to-be-relevant portions of the Sproull reference no mention is made of the TiO₂ content specifically described throughout the reference including the passage of the Abstract to which the examiner pointedly refers. There appears to be an intent to disregard the teachings of the applied reference and to "read them out" of the reference partially because, according to the statements in the Action, "titanium dioxide is a known colorant that does not materially affect the basic and novel characteristics". This of course is entirely contrary to the content of the applied document.

The rejection is thus based upon a modification of the Sproull disclosure, modification of which would ignore one of the essential ingredients. The MPEP also speaks to this point as well:

"The proposed modification cannot render the prior art unsatisfactory for its intended purpose. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." *See* MPEP §2143.01.

As applied in the Official Action, the proposed modification of the Sproull reference would render it unsatisfactory for its intended purpose. Quite plainly then there is no motivation

or suggestion to read the document in such a manner and for these reasons the rejection is flawed and should be withdrawn.

Applicant takes specific issue with two statements made in the Official Action which they believe are inconsistent with current knowledge in this area and in any event appear to find no basis in the record of the present application.

The two statements are as follows:

1. "Titanium dioxide is a known colorant that does not materially affect the basic and novel characteristic(s) of the claimed invention (In re Herz, 537 USPQ 461, 463) as noted in M.P.E.P. 2111.03."
2. "The 1 weight percent of titanium dioxide in Sproull will not materially affect the basic and novel characteristic(s) or functionality of the claimed invention."

Considering the above, applicants exercise their rights under 37 CFR §1.104(d)(2). That is, when a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data must be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee; such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

Applicants specifically request the examiner to provide evidence in the form of an affidavit supporting the two statements quoted above which in part form a basis for continuing the rejection of all claims in this application. In the absence of such affidavit or other factual information, the rejection can not be supported as it is not compliant with the US PTO rules for rejecting claims in an Official Action; *see* generally Rule 104 as well as the passages mentioned above.

Apart from the above misapplication of the Sproull reference, no motivation has been established to combine the references. The mere fact the references can be modified or combined is not enough. As stated by the Court in *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-1784 (Fed. Cir. 1992)(emphasis added):

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.

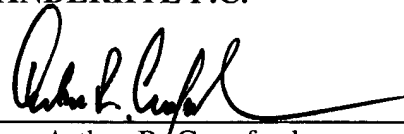
Thus, the mere fact that references can be combined or modified (Applicants believe they cannot be) does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed.Cir. 1990); MPEP § 2143.01. Hence, the Examiner's attempt to combine the cited references alone without any suggestion in the references of the desirability of the modification is improper and should be withdrawn.

Reconsideration and favorable action are solicited.

Respectfully submitted,

NIXON & VANDERHYE P.C.

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